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EXAMINER

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| ART UNIT | PAPER NUMBER |
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3629

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/653,224
Filing Date: August 31, 2000
Appellant(s): MAYES, ROBERT C.

Jack H. McKinney
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/10/2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of claimed subject matter*

The summary of claimed subject matter in the brief, claims 1, 7 and 12, is correct.

(6) *Grounds of rejection to be reviewed*

The appellant's statement of the issues in the brief is partially correct. Appellants have not argued/challenged the rejections of claims 1, 4-6, 7-11 and 12-15 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Therefore, the rejections of claims 1, 4-6, 7-11 and 12-15 under 35 U.S.C. 112, second paragraph, remain standing.

(7) Prior Art of Record

| | | |
|-----------|--------------|---------|
| 6,012,890 | GARRIDO | 01-2000 |
| 4,598,376 | BURTON et al | 07-1986 |

Claim Rejections - 35 USC § 112

1. Claims 1, 4-6, 7-11 and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1, 7, 12, It's not clear the phrase "selecting format criteria and page and cover media" is with respect to what? Changing the phrase to "selecting the book format criteria and book page and book cover media" is recommended to improve clarity.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 4-6, 7-11, 12-15 are rejected under 35 U.S.C. 103(a) as obvious over GARRIDO (US Patent 6,012,890) in view of BURTON et al (US Patent 4,598,376).**

As for independent method claim 1, GARRIDO fairly discloses a manufacturing method of item, i.e. book, comprising:

(a) identifying a set of items (books) {see col. 4, lines 40-45 (or c4:40-45 for simplicity)};

(c) selecting the item's (book's) dimension parameters, a format criteria which includes at least a font size, and page and cover media {see c7:8-60, c9:1-10 which discloses "paper size, font size, and type"; c8:65-67 which discloses "cover can be printed"; c9:1-10 which discloses "numbering of pages, type and size of fonts, design of printed matters, graphics to be included"}, and

(d) manufacturing the set of items (books) according to customer's needs or input information or data {see c9:5-10}. Note that on c7:5-15, 23-27, GARRIDO discloses the selection of the book's parameters, such as paper size, font size and type, etc., according to the customer's needs and or desires. Alternatively, the selection of other well known book's dimension parameters would have been obvious to a skilled artisan as mere routine experimentation to meet the specific needs. Therefore, GARRIDO fairly teaches the claimed invention except for:

(b) receiving a dimension information of an item (book) storage space or holder or wherein the customer's need is fitting the item (book) storage space or holder and carrying out steps (c) and (d) according the dimension information of (b) or item holder or storing space parameters.

In a similar method and apparatus to overcome traditional manufacturing inefficiency by the "off-the-rack or shelf" or "off-inventory" method for producing items,

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BURTON replacing this traditional method with a custom manufactured items or made-to-measure process (see c1:8, c3:22-23) to produce items that will fit the item holder precisely at once according to measurement, BURTON discloses an item manufacturing method to encompass this scope comprising:

- (a) identifying a set of items (garments, vests, suits),
- (b) receiving an information with respect to the dimension (or measurement) of the item holder (customer's body),
- (c) selecting the item format criteria according to (b), the selection being made so that the set of items, once manufactured, will fit within the item holder , and
- (d) manufacturing the set of items (vests, suits) according to the selected format criteria. (see c1:8, c1:48-55, c2:1-3, c5:25-40) for the benefits of: increase efficiency by 1) fitting the item holder precisely at once according to measurement, 2) reducing waste in materials due to alteration, cost of alteration, or time waiting for alteration, or 3) reducing high overhead cost in inventory due to "off-the-rack" or "off-the-shelf" or "off-inventory" method (see general teachings on col. 1). Note that on c1:7-10, BURTON et al discloses a method and apparatus for producing custom manufactured items and has particular utility for producing individually tailored suits and on c11:10-16, that the manufacturing process need not be limited to a men's suit and that all alterations and/or modifications falling within the scope of the claimed invention.

Therefore, it would have been obvious to modify the "made according to input data" process teaching of GARRIDO by including the teachings of "made-to-measure" by selecting the book's parameters using step (b) and the modification of steps (c) and

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(d) as taught by BURTON (or according to item holder's dimension) according to the received dimension (or measurement) of the item holder to properly fit the item holder for at least one of the benefits as taught by BURTON above: 1) fitting the item holder precisely at once according to measurement, 2) reducing waste in materials due to alteration, cost of alteration, or time waiting for alteration, or 3) reducing high overhead cost in inventory due to "off-the-rack" or "off-the-shelf" or "off-inventory" method. As for the different in the type of item, book vs. suit, another particular utility, this is not critical and within the skill of the artisan, manufacturing engineer, as mentioned by GARRIDO above. In other word, mere applying the same manufacturing steps to other similar/equivalent items to obtain similar results would have been obvious to a skilled artisan in the manufacturing art, absent evidence of unexpected results.

As for any difference between item holder or item storage space, this is merely difference in the term or language use to describe a general item holding and is within the knowledge of the artisan or would have been obvious as various way of describing an item holding/storing area. Note that the key issue is measuring the item in advance according to the dimension information of the item holder prior to manufacturing to fit the desired item holding once manufactured and reducing waste or not fitting. The application of this concept to any item and item holder/storing space would have been obvious. As for the limitation of selecting the other book's dimension parameters, a format criteria and page and cover media, according to the received dimension, these are inherently included in the teachings of GARRIDO in view of BURTON et al as described above.

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For, example, selecting a font size too high or big will increase the book thickness or height which may not fit the book holder. Selecting a cover so large would not fit into the holder properly.

As for dep. claims 4-6 (part of 1 above), the steps for receiving payment information before or after manufacturing are well known/conventional to pay for the books and would have been obvious to a skilled artisan or inherently included in the teaching of GARRIDO or BURTON et al.

4. **As for independent apparatus claim 7**, this is fairly taught in book on-demand system of GARRIDO as shown in Fig. 1, 2A, 2B, 3 and c2:60-65, c3:1-20, c4:40-50, c5:60-67, c6:30-67, c7:1-60 and in view of the teachings of BURTON as shown in claim 1 above. Alternatively, the setting up of equivalent system to carry out the equivalent method claim (claim 1) is within the skill of the artisan and would have been obvious to a skilled artisan.

As for dep. claims 8-9 (part of 7 above), these have the same limitations as in claims 4-6 above and are rejected for the same reasons set forth above.

As for dep. claims 10-11 (part of 7 above), these are fairly taught in GARRIDO c2, line 65 to col. 3, line 30, c5:40-67, c6:40 to c7, line 20.

5. **As for Independent product claim 12**, this is rejected over the computer readable media in the computer system of GARRIDO and in view of the teachings of BURTON (computer system and measuring devices as in c11: 5-16) as shown in Independent method claim 1 above. Alternatively, the setting up of equivalent computer

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readable media to carry out the equivalent method claim (claim 1) is within the skill of the artisan and would have been obvious to a skilled artisan.

As for dep. claims 13-15 (part of 12 above), these have the same limitations as in claims 4-6 above and are rejected for the same reasons set forth above.

In summary, the general teaching of BURTON to overcome traditional manufacturing inefficiency by the "off-the-rack" or "off-the-shelf" or "off-inventory" method for producing for items, BURTON replacing this traditional method with a custom made (or made-to-measure process, or tailored or manufactured made) method to produce items that will fit the item holder. The selection of any other personal item and item holder such as book and book holder (or book storage space) is within the skill of the artisan and would have been obvious. The combination of this teaching into GARRIDO, a book on-demand system, would yield the claimed invention and overcome all of the problems mentioned in the specification.

Response to Arguments

6. Applicant's argument (7.A.1) that there is no suggestion or motivation to combine BURTON et al with GARRIDO is not persuasive in view of the benefits of made-to-measure cited above, paragraph no. 3 or BURTON et al col. 1, line 25 to col. 2, line 10.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

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1986). Both GARRIDO and BURTON et al deals with general process for manufacturing items. BURTON et al teaches the input of dimension data or measurement data of the item's holder for manufacturing of the item that would fit the holder efficiently (in this case, the item is the suit or vest and the item's holder is the customer's body). Note that on c1:7-10, BURTON et al discloses a method and apparatus for producing custom manufactured items and has particular utility for producing individually tailored suits and on c11:10-16, that the manufacturing process need not be limited to a men's suit and that all alterations and/or modifications falling within the scope of the claimed invention. The application of BURTON et al's manufacturing style, made-to-measure, to other manufacturing item, i.e. book, in GARRIDO, with item's holder (or storage space), book shelf, for the benefits of fitting efficiently and other benefits as mentioned would have been obvious to a skilled artisan. In other word, one would carry out step (b) and modify steps (c) and (d) of GARRIDO as taught by BURTON et al to obtain the benefits as taught in BURTON et al.

Applicant's argument that nothing in GARRIDO or BURTON et al teaches selecting the book (item) dimension parameters such as format criteria, page and cover media according to the received dimensions, is not persuasive in view of GARRIDO col. 7, lines 5-55 and the teachings of BURTON et al as cited above.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

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within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, BURTON et al teaches the input of dimension data or measurement data of the item's holder for manufacturing of the item that would fit the holder efficiently (in this case, the item is the suit or vest and the item's holder is the customer's body). Note that on c1:7-10, BURTON et al discloses a method and apparatus for producing custom manufactured items and has particular utility for producing individually tailored suits and on c11:10-16, that the manufacturing process need not be limited to a men's suit and that all alterations and/or modifications falling within the scope of the claimed invention. The application of BURTON et al's manufacturing style, made-to-measure, to other manufacturing item, i.e. book, in GARRIDO, with item's holder (or storage space), book shelf, for the benefits of fitting efficiently and other benefits as mentioned would have been obvious to a skilled artisan. In other word, one would carry out step (b) and modify steps (c) and (d) of GARRIDO as taught by BURTON et al to obtain the benefits as taught in BURTON et al.


In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant's arguments based on the specific utility of the item, book vs. vest, and the specific utility of the item's holder, book storage area or shelf vs. customer's

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body, the specific utility is obvious and within the skill of the artisan as taught by BURTON et al on c1:7-10 or c11:10-16. Moreover, mere applying the same manufacturing steps to other similar/equivalent items to obtain similar results would have been obvious to a skilled artisan in the manufacturing art, absent evidence of unexpected results. No subjective evidence has been submitted to show why other specific utility of the items, i.e. vest or suit, would not work on book.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Tan Dean D. Nguyen
Primary Examiner
Art Unit 3629

Dean Tan Nguyen

January 19, 2005

Conferees

X John Weiss, SPE *1-19-05*
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